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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,576	03/31/2000	Robert G. Field	SUNIP252/P4198	2536
22434	7590	12/09/2003	EXAMINER	
BEYER WEAVER & THOMAS LLP			KISS, ERIC B	
P.O. BOX 778			ART UNIT	
BERKELEY, CA 94704-0778			PAPER NUMBER	
			2122	18

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PR 9

Interview Summary

Application

09/540,576

Applicant(s)

FIELD ET AL.

Examiner

Eric B. Kiss

Art Unit

2122

All participants (applicant, applicant's representative, PTO personnel):

(1) Eric B. Kiss.

(3) R. Mahboubian (Reg. 44,890).

(2) Tuan Q. Dam.

(4) _____.

Date of Interview: 05 December 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: 1 and 20.

Identification of prior art discussed: JavaOne '98 and JavaOne '99 presentation slides; and Aho et al..

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Eric B. Kiss

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiner's Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Mr. Mahboubian suggested that of the two slideshow presentations submitted (IDS; Paper No. 6), only the 1998 presentation qualifies as Prior Art, and that the Office action appears to have referenced the 1999 presentation in making a rejection under 35 U.S.C. §102(b), based on public use. Evidence supporting such a claim was provided, namely the numbering of slides referred to in the detailed statement of rejection. The Examiner did not dispute this point, but offered that the actual grounds of rejection stated is based upon the 1998 presentation, and it is believed that the 1998 presentation slides provided by Applicant still support the reasoned statements of the rejection. Mr. Mahboubian suggested that the rejection is improper based on this, and this issue would be taken up with the Board of Patent Appeals and Interferences.

During detailed discussion of the 1998 presentation slides, Mr. Mahboubian asserted that the slides do not even remotely suggest parsing or the use of a code generator in arriving at the illustrated implementation, further suggesting that, at the time of the 1998 presentation, the Inventors had not conceived of such parsing and code generation as a means of arriving at a working implementation of the 1998-presented invention. Mr. Mahboubian asserted that there is no burden of proof on his side of prosecution to establish a prima facie case of unobviousness, and that he had complied fully with the duty to disclose information material to patentability in compliance with 37 CFR §1.56. However, the Examiner asserted that a prima facie case of obviousness had already been established as set forth in the Office action (mailed September 24, 2003; see p. 18, last paragraph, continuing onto p. 19) as the alternative grounds of rejection to "public use" under 35 U.S.C. §102(b). The Examiner further asserted that the Aho et al. reference cited in the Office action (which Mr. Mahboubian acknowledged as providing a basic "Compilers 101" teaching, i.e., well within the reach of one of ordinary skill in the art) provides ample evidence that it has been known to parse (performing syntax analysis on) high-level code and generate machine-executable code (using a code generator) in order to arrive at an executable software implementation (see Aho et al., Fig. 1.9 on p. 10 and the discussion of syntax analysis (parsing) on pp. 6-8), such as that illustrated in the 1998 presentation slides. Although Mr. Mahboubian had asserted that the parsing of the disclosed high-level JDWP specification was not even remotely suggested, the Examiner maintained that it would have been obvious to one of ordinary skill in the art at the time of the 1998 presentation to utilize known implementation techniques for parsing (performing syntax analysis on) high-level descriptions of software (such as source code) and using a code generator to produce machine-executable descriptions as a necessary means of realizing the intended functionality of the high-level description. Mr. Mahboubian was unwilling to make any agreement with regard to this argument.



TUAN DAM
SUPERVISORY PATENT EXAMINER